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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,779	11/10/2003	Satoshi Mizutani	20050/0200471-US0	4389
7278	7590	08/01/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/705,779	Applicant(s) MIZUTANI, SATOSHI	
	Examiner Jacqueline F. Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 5/4/05 have been fully considered and they are partially persuasive.
2. With regard to the rejection of claims 1, 2, and 7 under 35 U.S.C. 102(b) as being anticipated by Johnson USPN 4595392, applicant's arguments are not persuasive. Applicant argues that Johnson does not anticipate claims 1, 2, and 7 because Johnson does not show the interlabial pad is folded and attached from about the middle towards one end of the peripheral edges of the back sheet to create a cylindrical portion for inserting a finger in the longitudinal direction and Johnson instead shows an interlabial pad that is folded and secured with securement dots to form a raised cyclindroidal centrall disposed portion. The manner in which the article is folded to form a cylindrical portion is directed to an intended use of the article. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

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Regarding the rejection of claims 1-6 and 8-11 under U.S.C. 103(a) as being unpatentable over Rosenbluth USPN 5336208 in view of Belecky et al. USPN 5672165, the arguments are moot in view of the new grounds of rejection.

### ***Claim Objections***

3. Claim 14 is objected to because of the following informalities: the limitation "the unwrapping opening of said individual wrapping body" lacks antecedent basis. Appropriate correction is required.

### ***Claim Interpretation***

4. In claim 14, the limitation "the unwrapping opening of said individual wrapping body" is interpreted opening to mean the surface whereby the wrapping body is opened in use. This term is given its broadest reasonable interpretation and can be interpreted as the top or bottom surface or either side surface.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 4, 7, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson USPN 4595392.

As to claims 1 and 8, Johnson discloses an interlabial pad having a water-permeable surface side sheet 7, an absorbent body 6, and a back side sheet 8. The interlabial pad comprises a cylindrical portion 3 in which a finger can be inserted for use (Figure 3), wherein the cylindrical portion 3 comprises the sheets 7 and 8 and absorbent body 6 (Figure 3). Applicant admits the cylindrical portion of the present invention may be formed only when a finger is inserted therein (specification page 4, second paragraph). Therefore, the manner in which the cylindrical portion is formed is directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claim 3, see Figure 2

As to claim 4, see Figure 3.

As to claim 7, Johnson discloses the interlabial pad has a tacking agent 4 on an inner surface of the cylindrical portion (Figures 2 and 3).

As to claims 10 and 11, the claims are directed to an intended use of the article. see the discussion of claim 1 with regard to intended use limitations.

7. Claims 1, 2, 5, and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by McFall USPN 6183587.

As to claim 1, McFall discloses an interlabial pad having a water-permeable surface side sheet , an absorbent body 22, and a back side sheet (Figures 39 and 40 and col. 27, lines 1-19). The interlabial pad comprises a cylindrical portion 3902 in which a finger can be inserted for use (Figure 40). Applicant admits the cylindrical portion of the present invention may be formed only when a finger is inserted therein (specification page 4, second paragraph). Therefore, the manner in which the cylindrical portion is formed is directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claim 2, see Figure 39 the areas surrounding 3900,3902 are considered the flap portions.

As to claim 5, McFall discloses the cylindrical portion comprises an extensible material (col. 27, lines 20-30)

As to claim 9, McFall discloses the an embodiment where the wearer inserts her hand in the absorbent, which has an another tub of absorbent on the base sheet 24. In which case, the surface sheet would be outside an inside the cylindrical portion.

As to claims 10 and 11, the claims are directed to an intended use of the article.  
see the discussion of claim 1 with regard to intended use limitations.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson USPN4595392 in view of Farris et al. USPN 6131736.

As to claims 12-16, Johnson does not disclose a wrapping sheet for covering and enclosing the interlabial product. Farris et al. discloses a packaging device including a wrapping sheet 40 for the benefit of storing the interlabial device until ready for use in such a manner that the user neither touches nor contaminates the surface of the absorbent in handling (Farris col. 5, lines 45-52). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Johnson to include a packaging device for the benefits taught in Farris.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-16 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6-13, 15-16 of copending Application No. 10705408. Although the conflicting claims are not identical, they are not patentably distinct from each other because a change in size is



generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-16 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10705780. Although the conflicting claims are not identical, they are not patentably distinct from each other a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacqueline F Stephens  
Examiner  
Art Unit 3761

July 25, 2005